

### REMARKS

Claims 1-20 and 68-79 are pending in the present application. In the Non-Final Office Action mailed March 28, 2007, claims 1-20 and 68-79 stand rejected. Reconsideration of the present application in view of the remarks that follow is respectfully requested.

### Claim Rejections

Claims 1-5, 10-14, 19 and 20 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2004/0147928 to Landry et al. (hereafter "Landry") while claims 6-9, 15-18 and 68-79 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Landry reference in view of U.S. Patent No. 6,610,065 to Branch et al. (hereafter "Branch"). For at least the reasons that follow, each of claims 1-20 and 68-79 is submitted as patentable over the cited references.

It is well established that "an invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co. Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The claims must not be treated as "mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al., 730 F.2d 1452, 1459, 221 USPQ 481, 486 (Fed. Cir. 1984). As a result, a reference that coincidentally lists features of a claim without describing the claimed arrangement, relationship, and organization of such features cannot anticipate.

As an initial matter, Applicants reserve the right to remove Landry with an affidavit under 37 C.F.R. §1.131 in this and any continuing applications. However, assuming only *arguendo* that Landry may be asserted with respect to the present application, it is believed that claims 1-5, 10-14, 19 and 20 are patentable thereover as will be explained in the following comments.

For example, claim 1 recites, among other features, "...said guiding portion is flexible and positionable between an untaut configuration and a taut configuration as the implant is guided therealong." The Office Action has failed to specifically indicate which portion(s) of Landry disclose(s) that guide member 100 is positionable between an untaut configuration and a

taut configuration as an implant is guided therealong. Instead, the Office Action generally references various paragraphs and figures of Landry (e.g. ¶s 51-57, 63, 70, 100-101 and 112-115) which assertedly disclose the features of independent claim 1. After a thorough review of both the referenced portions and the remainder of Landry, it is submitted that Landry only discloses that guide member 100 may be flexible and used during minimally invasive surgery to place various components relative to one or more vertebrae (see e.g. ¶ 50, lines 1-3 of Landry), but with respect to the flexibility of guide member 100, Landry does not disclose that guide member 100 is positionable between an untaut and taut configuration. Rather, Landry specifically discloses that guide member 100 includes a stiffness along the length thereof. See e.g. ¶ 52, lines 1-2 of Landry. Likewise, as would be appreciated by those of ordinary skill in the art, the disclosure of a flexible guide member 100 that has stiffness along its length does not teach, suggest or disclose that guide member 100 is positionable between a taut and untaut configuration. Accordingly, claim 1 is submitted as patentable over Landry for at least this reason.

In addition to the above, Applicants further submit that Landry discloses additional reasons why one of ordinary skill in the art would appreciate that guide member 100 includes a stiffness and is not positionable between an untaut and taut configuration. For example, guide member 100 includes threads 104 which engage with threads of section 130 of threaded member 108. See e.g. Figure 6 and ¶ 64, lines 7-10 of Landry. Additionally, guide member 100 is used for guiding and placing a driver member 134 into communication with threaded member 108. See e.g. ¶ 70, lines 8-11 of Landry. If guide member 100 were positionable in an untaut configuration, rotating guide member 100 to threadingly engage threads 104 with member 108 would not be possible with the disclosed configuration of guide member 100 since the torque required to engage threads 104 by rotating the proximal portion of guide member 100 would not be effective to create the threaded engagement, particularly considering that section 130 is positioned entirely internally relative to the end of threaded member 108. Therefore, guide member 100 requires stiffness to engage threads 104 with member 108.

In addition, positioning driver member 134 over guide member 100 in an untaut configuration would not be possible unless a constant tension were applied to guide member 100 during the guidance of driver member 134 thereover. However, when considering the

configuration of driver member 134, it is clear that a constant tension could not be applied to guide member 100 as driver member 134 is placed thereover. Even further, Landry discloses guide member 100 may be positioned through driver member 134 to engage with threaded member 108. See ¶ 100, lines 10-13 of Landry. However, if guide member 100 included an untaut configuration, it would also be extremely impractical, if not impossible, to engage guide member 100 with section 130 of threaded member 108 as guide member 100 is positioned through both the long passage of driver member 134 and passage 122. Accordingly, as would be appreciated by one of ordinary skill in the art, Landry does not disclose that guide member 100 is positionable between an untaut and taut configuration. If this ground of rejection is maintained, Applicants respectfully request further explanation, or specific citation(s) to the relevant portion(s) of Landry, which support the assertion that guide member 100 is positionable between an untaut and taut configuration.

Withdrawal of this rejection and allowance of claim 1 are respectfully requested. Each of claims 2-5 depends from base claim 1 and is submitted as patentable for at least the reasons supporting the patentability of claim 1. Additionally, claims 6-9, which depend from base claim 1 or an intervening claim, have been rejected as unpatentable over the Landry reference in view of the Branch Patent. In order for an obviousness rejection to be proper, the combination of prior art references must teach or suggest all the claim limitations. See Manual of Patent Examining Procedure (MPEP) §2142 (*citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). As set forth above, Landry fails to disclose a guiding member positionable between an untaut and taut configuration. Likewise, this feature is also not disclosed by Branch. Accordingly, claims 6-9 are also submitted as patentable over Landry in view of Branch.

As indicated above, independent claim 10 has also been rejected under 35 U.S.C. §102(e) as being anticipated by Landry. Claim 10 recites, among other features and elements, "... wherein said guiding portion is structured to move between a loose condition and a taut condition." For at least the reasons discussed above, it is respectfully submitted that Landry also fails to disclose at least these features of claim 10. Accordingly, claim 10 is submitted as patentable thereover. Each of claims 11-14, 19 and 20 depends from base claim 10 or an intervening claim and is submitted as patentable for at least the reasons supporting the patentability of claim 10. Additionally, claims 15-18 have been rejected as being unpatentable

over Landry in view of Branch. However, the combination of Landry and Branch fails to teach or suggest all the limitations of these claims. Accordingly, withdrawal of these rejections and allowance of base claim 10 and the claims depending therefrom are respectfully requested.

Independent claim 68 also stands rejected as being unpatentable over Landry in view of Branch. Claim 68 recites, among other features and elements, "said connecting portion includes a body and a pair of extensions extending distally from said body, said distal extensions each include an engagement portion extending therefrom releasably engageable with the bone anchor." The Office Action asserts that Landry discloses all the features of claim 68 "except for a connecting portion including a pair of extensions to releasably engage with the bone anchor." See Office Action, page 3. The Office Action further asserts that it would have been obvious to modify Landry in view of the teachings of Branch in order releasably fasten and secure guide member 100 to an anchor. See Office Action, page 3.

The seminal case directed to application of 35 U.S.C. §103 is Graham v. John Deere, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). From this case, four familiar factual inquiries have resulted. The first three, determining the scope and content of the prior art, ascertaining differences between the prior art and the claims at issue and resolving the level of ordinary skill in the pertinent art, are directed to the evaluation of prior art relative to the claims of the pending application. The fourth factual inquiry is directed to evaluating evidence of secondary considerations. See Manual of Patent Examining Procedure (MPEP) §2141. From these inquiries, the initial burden is on the Examiner to establish a *prima facie* case of obviousness. For at least the following reasons, Applicants respectfully submit that a *prima facie* case of obviousness has not been established in this case.

More particularly, when considering the entire scope and content of Landry, one of ordinary skill in the art would have no reason to modify the Landry reference as suggested by the Office Action. As discussed above, Landry teaches that guide member 100 is engageable with section 130 which is positioned entirely within passage 122 of threaded member 108. Likewise, modifying guide member 100 to include "a pair of extensions extending distally from said body, said distal extensions each include an engagement portion extending therefrom releasably engageable with the bone anchor" would prevent guide member 100 from passing through the elongated and narrow passage 122 to engage with section 130. Furthermore, Landry teaches that

guide member 100 is structured to pass through the elongated and narrow passage of driver member 134 to engage with threaded member 108. It is respectfully submitted that modifying Landry in the suggested manner would prevent guide member 100 from passing through driver member 134 into engagement with threaded member 108.

Furthermore, Landry already teaches releasable engagement of guide member 100 with member 108 via a low profile threaded connection or other connection that is internal to the member 108. The Office Action asserts the reason for modifying Landry with Branch is in order releasably fasten and secure guide member 100 to an anchor. However, Landry already solves this problem with a releasable connection arrangement between guide member 100 and member 108. One of ordinary skill in the art would have no reason to further modify Landry to include the more complex connection arrangement of Branch when the device of Landry already solves the problem asserted to provide the reason for combining the references.

Furthermore, Branch is directed to an implant holder 50 which includes a gripping head 59 having a pair of gripping arms 60, 62 from which a pair of projections 64, 66 extend toward one another to engage the exterior of an implant. In contrast, it is clear that Landry discloses that guide member 100 engages with the internal passage of threaded member 108. Additionally, section 130 does not include any structure with which projections 64, 66 could releasably engage. Accordingly, even assuming only *arguendo* that guide member 100 was modified according to Branch, it is clear that the modified guide member 100 would no longer be engageable with threaded member 108 in the manner taught by Landry. Likewise, MPEP §2143.01 recites "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."

For at least these reasons, it is respectfully submitted that a *prima facie* case of obviousness has not been established. Accordingly, claim 68 is submitted as patentable over the combination of the Landry reference and the Branch patent. Each of claims 69-73 depends from base claim 68 or an intervening claim and is submitted as patentable for at least the reasons supporting the patentability of claim 68. Accordingly, allowance of claims 68-73 is respectfully submitted.

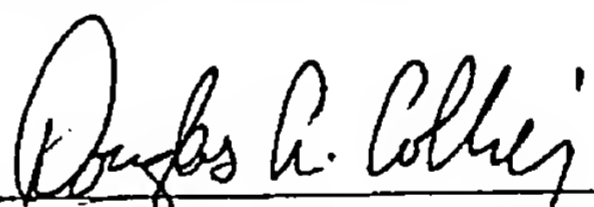
As indicated above, independent claim 74 has also been rejected as being unpatentable over Landry in view of Branch. Independent claim 74 recites, among other features and elements, "said connecting portion includes a body and a pair of extensions extending distally from said body, said distal extensions each include an engagement portion extending therefrom releasably engageable with the bone anchor." For at least the reasons submitted above with respect to independent claim 68, it is respectfully submitted that one of ordinary skill in the art would have no reasons to modify Landry in view of Branch as suggested by the Office Action to arrive at the invention of claim 74. Accordingly, claim 74 is submitted as patentable over the combination of Landry and Branch. Each of claims 75-79 depend from base claim 74 or an intervening claim and is submitted as patentable for at least the reasons supporting the patentability of claim 74.

#### CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that the Applicant's application is in condition for allowance with pending claims 1-20 and 68-79.

Reconsideration of the subject application is respectfully requested. Timely action towards a Notice of Allowability is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the subject application.

Respectfully submitted,

By:   
Douglas A. Collier  
Reg. No. 43,556  
Krieg DeVault LLP  
One Indiana Square, Suite 2800  
Indianapolis, Indiana 46204-2079  
(317) 238-6333 voice